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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/041,236 03/11/98 LUO

Y EX98-001

EXAMINER

HM12/0815

LEE, L

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ART UNIT

PAPER NUMBER

1645

14

DATE MAILED:

08/15/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/041,236

Applicant(s)

Luo et al

Examiner

LI Lee

Group Art Unit

1645



☒ Responsive to communication(s) filed on Jan 31, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 10-13 and 19-22 is/are pending in the application

Of the above, claim(s) 19-22 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 10-13 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

1. Applicant's response filed on Jan 31, 2000 (Paper Number 12) has been received and entered. Claims 10-13 and 19-22 are pending in the instant application. Claims 10-13 have been examined and claims 19-22 are directed to a non-elected invention.
2. The rejection of claims 10-13 under 35 U.S.C. 103(a) as being unpatentable over Ensser et al (GenEmbl Accession No. AF 030698, Submitted 10/21/97) and Sambrook et al (Molecular Cloning CSH, 1989) is withdrawn in view of Applicant's response that Ensser's publication of Genomics 51 (3), 340-350, 1998 is after the application's filing date 03/11/1998.

### ***Claim Rejections - 35 USC § 101***

3. Claims 10-13 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

The present claims are drawn to an isolated polypeptide sequence of SEQ ID NO:2, human semaphorin K1 and a recited length of the polypeptide of SEQ ID NO:2 which may or may not have the activity of the human semaphorin K1. However, the claimed polypeptide is not supported by a specific asserted utility because the disclosed use of the polypeptide sequence is generally applicable to any polypeptide sequence (e.g., modulating cellular physiology) and therefore is not particular the polypeptide sequence being claimed. Further, the claimed polypeptide is not supported by a substantial utility because the specification states only that the polypeptides are useful as immunogens for eliciting sema K1 rabbit antibody or to backtranslate

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sema K1 polypeptide-encoding nucleic acids or for functional studies (page 8). A starting material that can only be used to produce a final product does not have a substantial asserted utility in those instances where the final product is not supported by a specific and substantial utility. In this case none of the proteins or nucleic acids are to be produced as final products resulting from processes involving the claimed polypeptides have asserted or identified specific and substantial utilities. The assertion of using the claimed polypeptide sequences as diagnostic reagents by Applicant (page 7) to diagnose a non-specified disease, does not constitute a specific and substantial utility. An assay that measures the presence of a material (e.g., a binding agent specific to sema K1 polypeptides) which does not have a stated correlation to a non-particular disease condition does not define a "real world" context of use. Note, because the claimed invention is not supported by a specific and substantial asserted utility for the reasons set forth above, credibility has not been assessed. Neither the specification as filed nor any art of record disclosed or suggested any property or activity for the sema K1 polypeptides such that another non-asserted utility would be well established for the compounds.

Claims 10-13 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


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Papers relating to this application may be submitted to Technology Center 1600, Group 1645 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li Lee whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (703) 308-3909.

Li Lee

August 9, 2000

  
LYNETTE R. F. SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600